

III. REMARKS

Status of the Claims

Claims 1 -18 are amended. New claims 19 and 20 are added. Claims 1-20 are presented for further consideration. Claims 1,10, 17, 19, and 20 are independent.

The claims are amended for clarification. No new matter is presented. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

Claims 17 and 18 are amended in response to the rejection under 35USC101.

Applicant has considered the Examiner's comments set forth in the Office Action mailed May 28, 2008 and responds in detail below. Reconsideration of the application is respectfully requested in view of the amendments and the following remarks.

The Office Action

Applicant submits that this amendment to claims 17 and 18 fully remedies the basis for the rejection under on 35USC101.

Claims 1, 2, 4, 7-12, 13, and 16-18 stand rejected under 35USC102(b) on the basis of the cited reference Tsunoda, U.S. Patent No. 6,023,231. The Examiner is respectfully requested to reconsider the rejection in view of the above amendments and the following remarks. This rejection is traversed on the following grounds:

The cited reference Tsunoda fails to disclose each and every limitation of the claims of this application. It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221). In particular claim 1 as amended states:

"a circuit configured to produce, while said multimedia message is being composed, an indication when the size of the multimedia message exceeds said multimedia message size limit."

The reference Tsunoda, fails to disclose this feature.

Tsunoda teaches that an indication of excessive message length may be provided after transmission of the message. Tsunoda describes this at column 1, lines 55-67 as follows:

"According to an aspect of the present invention, in a message communication apparatus having a display and a transmitter, a limit length of transmission message is set and a predetermined length of message included in a transmission message is displayed such that a first part of the message which is not longer than the limit length is displayed in a first image and a second part thereof exceeding the limit length is displayed in a second image different from the first image. After transmitting the first part of the message through the transmitter, a predetermined indicator is displayed on screen for indicating that the second part is left without transmitted if the transmission message is longer than the limit length." (emphasis added)

The above text passage clearly indicates that the message is composed and at least partially transmitted. It has its final size, before it is displayed in first and second images. It is not until the display is presented showing what was transmitted and what was not that an indication is given. Furthermore, Tsunoda fails to teach that the message transmitted could be a multimedia message.

The solution of the claimed subject matter as amended provides the following advantage that is mentioned in page 3, lines 21-24 of the corresponding PCT-publication W02005/088992:

"An advantage of the invention is that the user is already when composing a message aware of the size limit and the transmission- related consequences

of surpassing the limit. Thus the user already when composing the message is aware of the relation of the message size to the defined size limit."

Tsunoda does not present any teaching that would provide the above-mentioned advantage. Nor does Chander (US7174177) present any teaching that would provide the above-mentioned advantage. Therefore, the amended independent claims involve an inventive step over the disclosures of Tsunoda and Chander.

For all of these reasons, the disclosure of Tsunoda, therefore, does not support the rejection of claim 1 based on anticipation. Since independent claims 10, 17, and new independent claims 19 and 20, each contains language equivalent to claim 1, these arguments also apply. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims.

Claims 3,5,6,12,14, and 15 are rejected under 35USC103(a) based on the combined teaching of the reference Tsunoda and the cited reference Chandler, U.S. Patent No. 7,174,177. This rejection is traversed on the following grounds:

The combined teaching of Tsunoda and Chandler does not render claims 3,5,6,12,14, and 15 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a *prima facie* case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."***

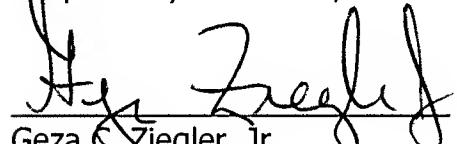
In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1,10, and 17 as indicated above. This also applies to new claims 19 and 10. These grounds apply equally to the rejected dependent claims, all of which,

by dependency, have the limitations described in the independent claims. The disclosure of Chandler fails to remedy the deficiencies of the primary reference Tsunoda.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of \$420 for increasing the number of independent claims by two and for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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Date

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